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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,094	12/05/2003	Young-Ho Hahn	25866	7288
20529	7590	11/01/2006		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER PAK, JOHN D	
			ART UNIT 1616	PAPER NUMBER

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,094

Applicant(s)

HAHN ET AL.

Examiner

JOHN PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Claims 1-4 are pending in this application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the reasons of record, which were fully set forth in the previous Office action of 2/17/2006, pages 2-5. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant's arguments relative hereto have been given due consideration but they were deemed unpersuasive. Applicant asserts that paragraphs 20-24 of the published application sufficiently describes Shengming Donglisu for adequate enablement because "[o]ne of skill in the art would understand the necessary extraction of minerals required to obtain shengming donglisu based on the teachings of the instant application." The Examiner cannot agree. The paragraphs are reproduced below for closer review.

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[0020] The object of the present invention can be achieved by providing a mineral water composition which comprises Sengmin donglisu.

[0021] Sengmin Donglisu comprised in the mineral water composition of the present invention is a mixture of minerals which are extracted from the natural ores such as celestine, paigeite, vermiculite, limestone, mica, colorata and elvan.

[0022] Sengmin Donglisu of the present invention, is composed of more than twenty (20) kinds of minerals which are known to have effect on the physiological activities of human body.

[0023] Also, Sengmin Donglisu may be employed to make a drink water, which is effective on enhancing human

immune system, promoting blood circulation, preventing and treating of the diseases such as diabetes, stomachic disorder and so on.

[0024] A more discussion in detail is fully described in Chinese patent application No.00121456.X which is incorporated by reference, including any drawings, as if fully set forth herein.

Paragraphs 21-22 disclose that "Sengmin Donglisu" (note spelling inconsistency)<sup>1</sup> is a mixture of more than 20 minerals which are known to have effect on the physiological activities of human body. But what are these minerals? How would one skilled in the art know which 20 or more minerals should be in shengming donglisu or perhaps something else that is spelled "sengmin donglisu"?

Paragraph 21 discloses that Sengmin Donglisu is extracted from natural ores such as celestine, paigeite, vermiculite, limestone, mica, colorata and elvan. So what is the extraction procedure? As noted in the Office action of 2/17/2006, different methods

of extraction would yield different products. Different temperature, different solvent, different techniques would all produce different compositions.

Paragraph 23 discloses the Shengmin Donglisu (note spelling inconsistency again) may be employed to make a drink water for various benefits but that does not further help the skilled artisan to make, obtain or extract the substance because it cannot be determined what exactly is in Shengmin Donglisu or Shengming Donglisu.

Paragraph 24 incorporates by reference a Chinese patent application. However, the issue here is enablement, i.e. one skilled in the art would not be able to determine what Shengming Donglisu is and therefore would not be able to obtain the composition claimed by applicant. 37 CFR 1.57 requires that incorporation by reference of essential subject matter is only permitted with U.S. Patent or U.S. Patent Applications. Essential subject matter includes subject matter necessary for enablement. 37 CFR 1.57(c). Consequently, the disclosure of the Chinese patent application cannot be incorporated by reference with respect to the subject matter at issue here.

For these reasons and the reasons of record, the claimed invention fails to find adequate enabling support from the disclosure because not being provided the exact content of Shengming Donglisu or how to extract it (including 20 or more minerals) from

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<sup>1</sup> Inconsistent spellings raise the question of whether the claimed "Shengming Donglisu" is the same substance as the described "sengmin donglisu" in these paragraphs.

various natural ores would lead one skilled in the art to resort to undue experimentation in order to arrive at the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record fully set forth in the Office action of 2/17/2006, page 6.

Applicant's arguments relative hereto have been given due consideration but they were deemed unpersuasive. Applicant refers the Examiner to the same paragraphs 20-24 (reproduced above) and argues that "shengming donglisu is described in such a way as to ensure that the scope of the claims is clear such that the public is informed of the metes and boundaries of the claims." The Examiner must strongly disagree. MPEP 2173 states, "The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." The Examiner queries how any person of any skill in the art would be able to tell the difference between mineral water with any combination of 20+ minerals and Shengming Donglisu. What exactly are the 20 or more minerals in Shengming Donglisu? What extraction steps are necessary to produce Shengming Donglisu from myriad natural

"ores?" The answer is unclear and so is the claimed invention. The Examiner maintains that the term "Shengming Donglisu," as recited in the instant claims is indefinite.

For these reasons and the reasons of record, this ground of rejection must be maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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